

## **REMARKS**

Claims 1-5 are pending in the present patent application. In the Office Action mailed January 9, 2004, the Examiner rejected claim 1 under the judicially created doctrine of obviousness-type double patenting and claims 1-5 under 35 U.S.C. § 103(a).

As set forth, Applicants have amended claim 1 to correct a typographical error. Further, after a careful review of the cited references, Applicants respectfully request reconsideration in view of the following remarks.

### **I. Priority**

The Examiner noted receipt of papers submitted under 35 U.S.C. § 119(e). However, the present application claims priority under 35 U.S.C. § 120 to U.S. Patent Application 09/227,086, filed January 5, 1999 (now U.S. Patent No. 6,304,523, issued on October 16, 2001), as noted on the filing receipt mailed October 30, 2001.

### **II. Double Patenting Rejection**

Claim 1 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,304,523. Applicants note that a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome a rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with the present application. Applicants decline to file a terminal disclaimer at this time. However, Applicants may do so upon allowance of the subject matter of the pending claims.

### **III. 35 U.S.C. § 103(a) Claim Rejections**

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,751,672 to Carl Yankowski (Yankowski) in view of U.S. Patent No. 6,327,233

Downs et al. (Downs). Applicants respectfully traverse. To establish a *prima facie* case of obviousness, the cited references must teach or suggest all the claim limitations. (MPEP § 2142).

Applicants submit that neither Yankowski nor Downs separately or in combination, teach or suggest an apparatus including “a controller … to repeatedly try to establish communication with the remote database,” and “to query the remote database using the indicating data when communication is established,” as in pending claim 1.

Yankowski teaches a method to link to a remote database that a user can utilize to provide information updates to a memory forming part of a CD player. The system uses a fingerprint of a CD to search a database for information such as title, track names, etc. (Yankowski, Col. 2, lines 52-57). A controller of the CD player reads the fingerprint and compares the fingerprint with those stored in the player’s memory. If no match is found, the user is asked if the disc is to be played or if the user wishes to attempt to retrieve data matching the fingerprint from a database. If the user decides to attempt to retrieve data, the fingerprint is sent to a computer. If the fingerprint is not found within the computer’s memory, the user can decide to have the computer initiate a call to a remote database via a modem and telephone line to attempt to retrieve the data. (Yankowski, Col. 8, lines 15-65).

Yankowski makes no mention of to repeatedly trying to *establish communication* with the remote database, as in pending claim 1. In contrast, Yankowski teaches alternate methods of attempting to find a matching fingerprint including only one attempt to contact a remote database. For example, as cited by the Examiner, in Yankowski at Col. 3, lines 46-56, Yankowski teaches that the controller includes capability for issuing a first query to the memory to determine if it includes information associated with the CD, and for issuing a second query to a remote database via the modem to find information associated with the CD if the first query

fails to locate the information. However, Yankowski includes no disclosure directed to failure of communicating the second query to the remote database.

Further, Yankowski does not teach all of the limitations of each of the dependent claims 2-5. For example, each of the dependent claims 2-5 includes a limitation directed toward the communication device being operable to communicate via wireless means, e.g., using cellular two-way network interface, an 802.11a network interface, an 802.11b network interface, or a Bluetooth network interface. The Examiner notes that Yankowski teaches that “[w]hile the present invention contemplates a conventional data modem connection using conventional telephone service, those skilled in the art will appreciate that a number of alternatives are possible such as ISDN networks and associated terminal adapters.” (Yankowski, Col. 6 line 65 to Col. 7 line 3). However, to establish a *prima facie* case of obviousness, the cited reference must explicitly teach or suggest all the claim limitations. Yankowski only teaches or suggests wired communication means. Thus, Yankowski does not teach any methods of wireless communication, and does not obviate any of the dependent claims 2-5.

Downs does not make up for the shortcomings of Yankowski. Downs teaches a method to gather information about the type of audience that listens to a particular CD. (Downs, Col. 1, lines 10-50). This method involves transmitting CD data, which corresponds to a selection played by the CD player, to a remote system. Downs does not involve retrieving information regarding a CD or any type of recording. Thus, Downs does not teach “a controller … to repeatedly try to establish communication with the remote database, to query the remote database using the indicating data when communication is established and to supply the textual recording name of the recording from the remote database to said memory,” as in pending claim 1.

Accordingly, since neither Yankowski nor Downs, separately or in combination, teach or suggest all the claimed limitations of pending claims 1-5, the asserted obviousness rejection of claims 1-5 should be withdrawn.

**IV. Summary**

Applicants respectfully submit that, in view of the remarks above, the present application, including claims 1-5, is now in condition for allowance and solicit action to that end.

If there are any additional matters that may be resolved through a telephone interview, the Examiner is requested to contact Applicants' undersigned representative at (312)-913-0001.

Respectfully submitted,

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